

**REMARKS/ARGUMENTS**

Claims 1-22 stand rejected.

Claim 10 has been canceled, without prejudice.

Claims 1 and 22 have been amended. Support for these amendments can be found throughout the specification and drawings, as originally filed.

**DRAWING OBJECTIONS**

Because the Examiner, in the Advisory Action, did not state any objections to the previously filed proposed drawing correction and/or the proposed substitute sheets of drawings filed on June 11, 2003, and specifically Fig.1, the Applicants assume that the previous objections to the drawings have now been overcome.

**REJECTION UNDER 35 U.S.C. §112, FIRST PARAGRAPH**

Claims 1-22 stand rejected under 35 U.S.C. §112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The Applicants respectfully traverse the 35 U.S.C. §112, first paragraph, rejection of claims 1-22.

In the interests of expediting prosecution of the instant application, and without admission that any amendment is necessary, the Applicants have amended the claims to more clearly define the invention.

The Applicants reiterate that a port, such as those described in the instant application, can function either as an intake or an outlet, i.e., fluid can be transported into the port or from the port. Thus, by way of a non-limiting example, fluid can be pumped from one of the worm trails 15, via port 19A, for example, and pumped into another adjacent worm trail 15, via port 19B, for example, and vice versa. See page 3, lines 14-22 of the Specification, which states:

*In a preferred embodiment, pump mounting face is external of the pump and uses existing oil pan or transmission fixtures. This provides for the necessary amount of oil for the inlet without using extra space in the pump housing, therefore, using less space inside the oil pan or transmission. **In a preferred embodiment, an existing valve manifold VM in a transmission has worm trails 15 configured to provide inlet and outlet porting. A porting plate 19 (which in a preferred embodiment is a valve manifold cover) is provided for providing intake or outlet porting holes, 19A and 19B, respectively, into the pumping chamber 17.** Alternatively, the plate 19 and pump housing 12 could be integral with one another. (Emphasis added).*

Accordingly, the Applicants submit that the 35 U.S.C. §112, first paragraph rejection of claims 1-22 has been overcome.

#### **REJECTION UNDER 35 U.S.C. §103(a)**

Claims 1-22 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Zepp et al. in view of Ford, Jr. et al.

The Applicants respectfully traverse the 35 U.S.C. §103(a) rejection of claims 1-22. The Applicants note that claim 10 has been canceled, without prejudice; therefore the rejection of claim 10 is moot.

The standard for obviousness is that there must be some suggestion, either in the reference or in the relevant art, of how to modify what is disclosed to arrive at the

claimed invention. In addition, "[s]omething in the prior art as a whole must suggest the desirability and, thus, the obviousness, of making" the modification to the art suggested by the Examiner. *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 1051, 5 U.S.P.Q.2d (BNA) 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988). Although the Examiner may suggest the teachings of a primary reference could be modified to arrive at the claimed subject matter, the modification is not obvious unless the prior art also suggests the desirability of such modification. *In re Laskowski*, 871 F.2d 115, 117, 10 U.S.P.Q.2d (BNA) 1397, 1398 (Fed. Cir.1989). There must be a teaching in the prior art for the proposed combination or modification to be proper. *In re Newell*, 891 F.2d 899, 13 U.S.P.Q.2d (BNA) 1248 (Fed. Cir. 1989). If the prior art fails to provide this necessary teaching, suggestion, or incentive supporting the Examiner's suggested modification, the rejection based upon this suggested modification is error and must be reversed. *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d (BNA) 1566 (Fed. Cir. 1990).

The law is also clear that a claim in dependent form shall be construed to incorporate all the limitations of the claim to which it refers. 35 U.S.C. § 112 ¶ 4.

Claim 1, as amended, recites, among other things, a pump for pumping fluid in a vehicle having at least one fluid reservoir, said pump comprising: (1) a pump housing having a pump element; (2) an electric motor operatively attached to said pump housing; (3) a pumping chamber, the pump element operatively coupled to said electric motor, said pumping chamber including an intake port for receiving fluid from said fluid reservoir and an exit port for pumping fluid from said fluid reservoir; and (4) at least one other intake port or exit port derived from porting configured in a surface adjacent to and not formed integrally with the pump, wherein said pump is submerged within said fluid

reservoir of said vehicle, wherein said fluid reservoir is selected from the group consisting of a transmission, transfer case, engine reservoir, and combinations thereof.

Neither Zepp et al. and/or Ford, Jr. et al., either alone or in combination therewith, suggests such structure. Specifically, Zepp et al., among other things, does not disclose that the pump is submerged within a fluid reservoir of a vehicle, wherein the fluid reservoir is selected from the group consisting of a transmission, transfer case, engine reservoir, and combinations thereof. Ford, Jr. et al. does not cure the deficiencies in the teachings of Zepp et al. Specifically, Ford, Jr. et al. teaches that the porting 34, 36 is integral to the pump element and not formed from a separate discrete component.

The Applicants submit that claim 1 is allowable over Zepp et al. and/or Ford, Jr. et al., either alone or in combination therewith. Furthermore, claims 2-9 and 11-21 dependent upon claim 1, are likewise allowable over Zepp et al. and/or Ford, Jr. et al., either alone or in combination therewith.

Claim 22, as amended, recites, among other things, a pump for pumping of fluid from at least one fluid reservoir of a vehicle, said fluid pump comprising: (1) a submerged pump housing; (2) a motor situated in said pump housing and exposed to the fluid in the fluid reservoir, said motor including a self centering armature therethrough; (3) a pump chamber at the base of said pump housing; (4) a pump element operably attached to said armature in said chamber for pumping fluid; (5) a surface adjacent to and not formed integrally with the pump housing and operatively associated with the pump chamber for providing inlet or outlet of fluid to the pump chamber contained in the pump housing, and said surface including at least one oil fill

passage connecting said fluid reservoir to said pump chamber for intake and pumping of said oil from said fluid reservoir, wherein said pump is submerged within said fluid reservoir of said vehicle, wherein said fluid reservoir is selected from the group consisting of a transmission, transfer case, oil reservoir, and combinations thereof.

Neither Zepp et al. and/or Ford, Jr. et al., either alone or in combination therewith, suggests such structure. Specifically, Zepp et al., among other things, does not disclose that the pump is submerged within a fluid reservoir of a vehicle, wherein the fluid reservoir is selected from the group consisting of a transmission, transfer case, oil reservoir, and combinations thereof. Ford, Jr. et al. does not cure the deficiencies in the teachings of Zepp et al. Specifically, Ford, Jr. et al. teaches that the porting 34, 36 is integral to the pump element and not formed from a separate discrete component.

The Applicants submit that claim 22 is allowable over Zepp et al. and/or Ford, Jr. et al., either alone or in combination therewith.

Accordingly, the Applicants submit that the 35 U.S.C. 103(a) rejection of claims 1-22 has been overcome.

## **CONCLUSION**

In view of the foregoing, the Applicant respectfully requests reconsideration and reexamination of the Application. The Applicant respectfully submits that each item raised by the Examiner in the Office Action of March 11, 2003 has been successfully traversed, overcome or rendered moot by this response. The Applicant respectfully submits that each of the claims in this Application is in condition for allowance and such allowance is earnestly solicited.

The Examiner is invited to telephone the Applicant's undersigned attorney at (248) 364-4300 if any unresolved matters remain.


Any needed extension of time is hereby requested with the filing of this document.

The Commissioner is authorized to charge any additional fees or credit any overpayment to Deposit Account No. 50-1612. A duplicate copy of this letter is enclosed herewith.

Respectfully submitted,

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